

PATENT

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Date: 3-26-04

Himanshu S. Amin

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4-9-04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Applicant(s): David S. Wehrle, *et al.*

Serial No: 09/546,093

Filing Date: April 10, 2000

Examiner: Bharat Barot

Art Unit: 2154

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Technology Center 2100

Title: POINTBUS ARCHITECTURE AND AUTOMATIC SEQUENTIAL ADDRESSING PROTOCOL

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Dear Sir:

Applicants submit this brief in triplicate in connection with an appeal of the above-identified patent application. The Commissioner is authorized to deduct \$330.00 for the fee associated with this brief from Deposit Account No. 50-1063 [ALBRP181US].

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Void date: 04/06/2004 TBESHAH1

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I. Real Party in Interest (37 C.F.R. §1.192(c)(1))

The real party in interest in the present appeal is Rockwell Automation Technologies, Inc., the assignee of the present application.

II. Related Appeals and Interferences (37 C.F.R. §1.192(c)(2))

Appellants, appellants' legal representative, and/or the assignee of the present application are not aware of any appeals or interferences which will directly affect, or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims (37 C.F.R. §1.192(c)(3))

Claims 1-9 are pending in the application. The rejection of claims 1-9 is being appealed.

IV. Status of Amendments (37 C.F.R. §1.192(c)(4))

No claim amendments have been made.

V. Summary of Invention (37 C.F.R. §1.192(c)(5))

The present invention relates to a protocol for automatic sequential addressing wherein the protocol comprises a first protocol that enables at least one I/O module to receive network communications and a second protocol that provides network communication to the at least one I/O module. Such a protocol can be utilized in conjunction with a control system to enable a user to build a precise input/output (I/O) system while mitigating the need to add racks, communications and power supplies. (*See* p.5, lines 4-6). This provides the user with a more granular I/O system while reducing node connection costs when additional I/O points are desired. (*See* p.5, lines 6-7).

VI. Statement of the Issues (37 C.F.R. §1.192(c)(6))

A. Whether claims 1-9 are unpatentable under 35 U.S.C. §102(e) as being anticipated by Crump, *et al.* (U.S. 6,484,206).

VII. Grouping of Claims (37 C.F.R. §1.192(c)(7))

For purposes of this appeal only, the claims are grouped as follows:

Claims 1-9 stand or fall together.

VIII. Argument (37 C.F.R. §1.192(c)(8))**A. Rejection of Claims 1-9 Under 35 U.S.C. §102(e)**

Claims 1-9 stand rejected under 35 U.S.C. §102(e) as being anticipated by Crump, *et al.* Reversal of the rejection is respectfully requested for at least the following reasons.

- i. Crump, et al. fails to disclose each and every element of claims 1-9 in the present invention; thus, Crump, et al. does not anticipate the subject claims.*

A single prior art reference anticipates a patent claim only if it expressly or inherently describes each and every limitation set forth in the patent claim. *Trintec Industries, Inc., v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 U.S.P.Q.2D 1597 (Fed. Cir. 2002); *See Verdegaaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 1 recites a protocol for automatic sequential addressing wherein the protocol comprises a ***first protocol that enables at least one I/O module to receive network communications and a second protocol that provides network communication to the at least one I/O module.*** Such a protocol can be utilized in conjunction with a control system to enable a user to build a precise input/output (I/O) system while mitigating the need to add racks, communications and power supplies. (*See* p.5, lines 4-6). This provides the user with a more granular I/O system while reducing node connection costs when additional I/O points are desired. (*See* p.5, lines 6-7). Crump *et al.* does not teach or suggest such limitations of the claimed invention.

More particularly, Crump *et al.* does not teach or suggest a protocol comprising a first protocol that enables at least one I/O module to receive network communications and a second protocol that provides network communication to the at least one I/O

* module as recited in the claimed subject invention. Examiner cites col. 4, line 34 – col. 5, line 32 of Crump *et al.* to teach this limitation. However, this section is not directed to a network structure wherein ***two protocols co-exist*** to facilitate communication, as recited in the claimed subject invention. Rather, Crump *et al.* simply discloses two ***independent protocols*** and a translating apparatus. A first protocol facilitates communication between a client(s) and a translating apparatus, and the translating apparatus communicates with a server *via* a second protocol. “[T]he clients communicate...over a first protocol network using a first communication protocol, and the translating apparatus communicates with the server over a second protocol network using a second communication protocol.” (col. 4, lines 38-43); “the server communicates with the translating apparatus over the second protocol network using the second communication protocol...” (col. 4, lines 54-60). The translating apparatus is utilized to convert the communication between the first and second protocols and simply acts as a proxy to allow the client(s) and server to communicate across a network. Thus, in Crump *et al.*, each protocol is ***isolated*** from the other and thus does not provide a network wherein two protocols are employed ***concurrently*** as recited in the subject claims.

* In addition, Crump *et al.* does not teach or suggest utilizing automatic sequential addressing as recited in the subject claim. In the Final Office Action dated October 2, 2003, the Examiner states that a sequential addressing scheme is inherent in the network disclosed in Crump *et al.* since “more than one client communicates with the translating apparatus over a first protocol network.” Applicants’ representative respectfully disagrees. “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The ***mere fact that a certain thing may result from a given set of circumstances is not sufficient.***’ ” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (emphasis added). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that ***the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.***” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis added).

Communication with a translating apparatus involving a plurality of clients does not inherently employ automatic sequential addressing as recited in the subject claim. For example, the mere fact that communication between a plurality of clients and a server may communicate utilizing a protocol does not necessitate the use of automatic sequential addressing. Further, Crump, *et al.* actually teaches away from subject invention since it teaches the use of *two disparate protocols* that act *independently* and *not concurrently* as recited in the subject claims.

Moreover, the communication link disclosed in Crump *et al.* does not disclose facilitating communication between a network and an I/O module as recited in the subject claim. Rather, Crump *et al.* discloses communication between a client (*e.g.* user) and a server (*e.g.* wireless telephone service). Therefore, there is no requirement for a sequential addressing schema, as recited in the subject claim, to be employed since each user is identified not by location (*e.g.* addressing) on a bus but rather by a preprogrammed ID number.

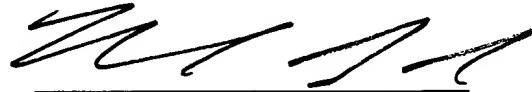
In view of at least the foregoing, it is respectfully submitted that Crump *et al.* neither anticipates nor suggests applicants' invention as recited in independent claim 1 (and claims 2-9 which depend therefrom), and this rejection should be withdrawn.

IX. Conclusion

For at least the above reasons, the claims currently under consideration are believed to be patentable over the cited references. Accordingly, it is respectfully requested that the rejections of claims 1-9 be reversed.

If any additional fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Respectfully submitted,
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X. Appendix of Claims (37 C.F.R. §1.192(c)(9))

1. A protocol for automatic sequential addressing, comprising:
a first protocol for enabling at least one I/O module to receive network communications; and
a second protocol for providing the network communications to the at least one I/O module.
2. The protocol of claim 1 wherein the first protocol enables at least one I/O module to enable at least one other I/O module to form an I/O group.
3. The protocol of claim 1 wherein the first protocol is a serial protocol.
4. The protocol of claim 3 wherein the first protocol includes a sync field, a size field, a command field, a data field, and a CRC field.
5. The protocol of claim 3 wherein the first protocol transmits data in selected intervals *via* an interrupt service routine.
6. The protocol of claim 5 wherein the selected intervals are groups of three to ensure data is sampled within a bit transition time.
7. The protocol of claim 3 further comprising a Generic broadcast, an Autoaddress, and a Generic Master Mode.
8. The protocol of claim 1 wherein the second protocol provides at least one of DeviceNet, EtherNet and ControlNet network communications.
9. The protocol of claim 1 wherein the second protocol further comprises class attributes, class services, and instance attributes.